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In re Application of
ROBERTSON, John Russell, et al.
Application No.: 09/857,739
PCT No.: PCT/GB99/04182
Int. Filing Date: 10 December 1999
Priority Date: 10 December 1998
Attorney Docket No.: B0192/7029 ERP
For: CANCER DETECTION METHODS AND
REAGENTS

NOTIFICATION

This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. §371.

BACKGROUND

On 10 December 1999, applicants filed international application PCT/GB99/04182, which claimed a priority date of 10 December 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 15 June 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 10 July 2000. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 June 2001 (10 June 2001 was a Sunday).

On 08 June 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee and a preliminary amendment. The preliminary amendment amends the specification to claim priority by referencing 35 U.S.C. §120, 35 U.S.C. §365(c) and international application PCT/GB99/04182.

On 03 July 2001, the United States Designated/Elected Office mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that applicant failed to provide an oath or declaration in compliance with 1.497(a) and (b) and the surcharge for filing of the oath or declaration after thirty months.

On 27 September 2001, applicants submitted, *inter alia*, a declaration pursuant to 37 CFR 1.497 and the surcharge for late filing of the declaration.

DISCUSSION

Conflicting Instructions

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The transmittal letter (Form PTO-1390) filed on 08 June 2001 identified the application as "a filing under 35 U.S.C. 371." However, the preliminary amendment amended the first line of the specification to reference 35 U.S.C. §120, 35 U.S.C. §365(c) and the PCT application. Applicants' reference to the disclosure as claiming priority under §§ 120 and 365(c) is inconsistent with the transmittal letter filed 08 June 2001 and contradicts the request in the transmittal letter to file under 35 U.S.C. §371. See, e.g., 35 U.S.C. §365. The transmittal letter (Form-1390) used by applicants is to be used only with submissions under 35 U.S.C. §371. Since applicants have given conflicting instructions, the papers are considered filed under 35 U.S.C. §111(a).

Continuation Application

Applicants are entitled to claim benefit under 35 U.S.C. §120 and §365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 09/857,739) and the international application (PCT/GB99/04182) designating the United States were copending on 08 June 2001.

Applicants are reminded that in order to perfect the claim for priority under 35 U.S.C. §119, applicants must submit certified copies of the priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP §1896.

Fees

The surplus from the difference between the filing fee for 35 U.S.C. §371 and the filing

fee for 35 U.S.C. §111 and the fee for a one month extension will be credited to Deposit Account No. 23-2825.

CONCLUSION

For the above reasons, the "Notification of Missing Requirements Under 35 U.S.C. 371" on 03 July 2001 is hereby **VACATED**.

This application is accepted as an application filed under 35 U.S.C. §111(a) with a filing date of 08 June 2001.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the International Division for processing in accordance with this decision, that is for (1) removal of the papers communicated from the International Bureau to the United States Patent and Trademark Office concerning international application PCT/GB99/04182, (2) correction of information in PALM (computer database) and (3) correction of fees. Afterwards, the application will be forwarded to the Office of Initial Patent Examination for processing as a national application filed under 35 U.S.C. §111(a) with a filing date of **08 June 2001**.

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